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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/697,421	08/23/1996	MICHAEL MOVALLI	06555.0001-0	9836
22852	7590	06/09/2003		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			EXAMINER KIM, AHSHIK	
			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant No.	Applicant(s)
	08/697,421	MOVALLI ET AL.
	Examiner	Art Unit
	Ahshik Kim	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05/19/03 (Amendment).
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 11-14 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 11-14 and 20-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>30</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Amendment

1. Pursuant to telephone interview on May 16, 2003, receipt is acknowledged of the
5 amendment (copy of the amendment dated October 29, 2002) faxed in to the Examiner on May
5/19/03.

In reviewing received fax, the Examiner noted incorrect Patent Application Serial No. on the first page. The Applicant wrote 08/679,421, which should have been 08/697,421. In fact, it appears that wrong serial number has been sporadically used in the past. Perhaps, the
10 amendment in question was lost due to this inadvertent error. Applicant is respectfully requested to ensure that papers to be filed contain the correct serial number (or other identifying information) for the application.

2. In the amendment, claims 1-10 and 15-19 were canceled. However, in the first paragraph
15 on page 2, the Applicant submits that claims 11-14 and 19-31 remains to be examined. Since claim 19 is canceled, claims 11-14 and 20-31 remain for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
20 obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
25 manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10 3. Claims 11-14 and 20-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dagger (US 5,748,737) in view of Aucsmith et al. (US 5,712,914).

Re claims 11-14, and 24, Dagger teaches a computer-implemented method of generating secure endorsed transaction (col. 7, lines 34+) wherein the transaction is comprised of a transaction identifier (i.e., unique code), which further includes a unique payer identifier and transaction data (col. 20, lines 20+). Parts or all of transaction record created can be encrypted (col. 19, lines 4+), which would be a single whole representation of a secure endorsed transaction. The card and card reader can be used with various attachment devices including a modem (col. 18, lines 30+) for transmitting transaction record. The transaction data can further be encrypted and decrypted using public key cryptography, creating a digital signature of the transaction record. Dagger further discloses additional tamper-proof measures ranging from hologram and use of hash-code (col. 2, lines 1+).

Although a unique payer identification disclosed in Dagger is capable of identifying who the payer is, and it does not necessarily provide authentic proof of a person. In the context

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provided in the amendment, the Examiner interprets “human identifier” as something more than an arbitrary number, although unique to that individual, to prove who he/she claims he/she is.

Aucsmith teaches a method and apparatus of initiating a transaction at point-of-sales terminal (col. 3, lines 6+) wherein the transaction data includes biometric information of the user (col. 2, lines 13+; see figures 4, 7). The system further comprised of a biometric input device (col. 4, lines 7+), inputting information such as fingerprints or retina scan.

In view of Aucsmith’s teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to include more authentic identifying information such as fingerprints or retina-scan in place of an arbitrary identification number taught by Dagger in order to further avoid fraudulent use by unauthorized person(s). Identification number such as Social Security Number, credit card number, or driver’s license number can be stolen, and be used in identify theft causing the victims considerable financial and other loss. By using more authentic information as data field of a transaction record, such loss can be prevented.

Moreover, improvement such as replacing arbitrary identification number with biometric information would have been obvious to one ordinary skill in the art, and therefore an obvious expedient.

Re claims 20-23, 25-27, and 29-31, the smart card reader/writer allows data be read or written to (col. 12, lines 8+).

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Additional Remarks

4. As indicated above, the Applicant canceled claims 1-10 and 15-19 in the latest amendment, and no claims were amended or newly added. Since previously Office Action (paper

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#29) rejected all outstanding claims 1, 3-7, 9-27, and 29-31 (before faxed amendment was received) under 35 U.S.C. 103(a) as being unpatentable over Dagger (US 5,748,737) in view of Aucsmith et al. (US 5,712,914), it is the Examiner's position that the cited references still teach all the claimed elements in instant application. In considering the latest amendment as requested by the Applicant, this Office Action is made non-final.

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Ahshik Kim
Patent Examiner
Art Unit 2876
June 4, 2003



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800